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In re Application of:  
Boris MAYER, et al.  
Application Serial No.: 10/820,586  
Filed: April 8, 2004  
For: **ELECTRONIC DEVICE FOR PACKET  
BOXES AND RELATED OPERATING METHOD**

**DECISION  
ON PETITION**

This is a decision on the petition requesting withdrawal of the final action, filed August 25, 2006, pursuant to 37 CFR § 1.181.

Petitioner alleges that the examiner erred in holding the Office action mailed June 26, 2006 final and requests withdrawal of finality of the Office action.

**PERTINENT BACKGROUND INFORMATION**

A non-final Office action was mailed on September 20, 2005 rejecting all claims 1-11 under 35 USC 103 as being unpatentable over Porter (US Patent No. 5,774,053) in view of Kakuta (US Patent No. 6,456,900).

Applicant filed an amendment on December 27, 2005, wherein all original claims 1-11 were canceled and new claims 12-20 were added.

On March 9, 2006, the Examiner made a Final Office action with a new grounds of rejection wherein all new claims 12-20 were rejected under 35 USC 103 as being unpatentable over Porter (US Patent No. 5,774,053) in view of Booth et al. (US Patent No. 6,879,243).

On May 15, 2006, applicant filed a response, including an after final amendment amending independent claims 12 and 13; and including a certified English translation of the German priority document.

On June 26, 2006, the examiner rendered a new final Office action citing a new grounds of rejection rejecting all of claims 12-20 as being rejected under 35 USC 103 over Porter (US Patent No. 5,774,053) in view of Frisch (US Patent No. 5,212,644) and setting forth that the new grounds of rejection were necessitated by amendment. The new final Office action dated June 26, 2006 was also mailed with an introductory paragraph (under "Response to Arguments") that the previous rejection was withdrawn.

An Interview Summary was mailed August 21, 2006 wherein the examiner's supervisor informed the attorney of record that the Final action mailed in June 26, 2006 was a replacement Final since the March 9, 2006 Final action was vacated.

On August 25, 2006, a petition to withdraw the holding of finality of the final rejection dated June 26, 2006 was filed. Petitioner argues that the new final Office action mailed June 26, 2006 was improper and premature. Petitioner contends that the new final rejection was necessitated by the filing of the foreign priority document, not as the result of a new amendment.

On October 31, 2006, applicant filed a Request for Continued Examination (RCE) and an Information Disclosure Statement. In the Remarks accompanying the RCE, applicant requests that any further action be held until resolution of the instant petition.

#### DECISION

It is noted that at the beginning of the June 26, 2006 Office action, the previous rejection was withdrawn. Although the examiner of record failed to clearly state that he was withdrawing the entire March 9, 2006 action, it can be understood from the record that was the examiner's intent. Furthermore, the examiner's supervisor clarified in an Interview Summary dated August 21, 2006 that the earlier action was vacated and that the new Final action mailed June 26, 2006 served as its replacement. Because the March 9, 2006 Office action was vacated, the new final Office action mailed June 26, 2006 was responsive to the December 27, 2005 amendment, which was reconsidered together with the certified translation of the foreign priority document filed May 15, 2006.

Regardless, the issue became moot with applicant's filing of an RCE on October 31, 2006. Applicant's request that 'any further action be held until resolution of the instant petition' is tantamount to the filing of a "conditional RCE", which is not permitted. In accordance with MPEP 706.07(h), a "conditional" RCE is treated as an RCE. Accordingly, the RCE filed October 31, 2006 has been processed.

For the reasons set forth above, the petition to withdraw finality is **DISMISSED AS MOOT**.

The application is being forwarded to the examiner for new and appropriate action responsive to the RCE filed October 31, 2006.



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